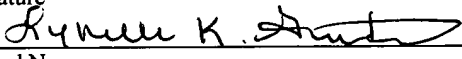


PATENT
Attorney Docket No.:117-P-1380USC3

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Minyu Li and Keith Darrell Lokkesmoe	
	Group Art Unit: 3651
Serial No.: 10/715,575	Confirmation Number: 4746
Filed: November 18, 2003	Examiner: Not known
For: CONVEYOR LUBRICANT AND METHOD FOR TRANSPORTING ARTICLES ON A CONVEYOR SYSTEM	

Certificate of Express Mailing	
Pursuant to 37 CFR 1.10, I certify that this correspondence is being deposited on the date indicated below with the United States Postal Service "Express Mail Post Office to Addressee" service addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.	
Express Mail No.: ED 240260199 US	Signature 
Date: October 28, 2004	Printed Name: Lynelle K. Grube

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to C.F.R. §§ 1.97 and 1.98, enclosed please find a completed PTO Form 1449 citing documents submitted for consideration during examination of the above-referenced patent application. A copy of each of the documents listed on the attached PTO Form 1449 form is also enclosed. Pursuant to the provisions of M.P.E.P. §609, Applicants request that a copy of the PTO Form 1449, marked as being considered and initialed by the Examiner, be returned with the next official communication.

This Supplemental Information Disclosure Statement ("SIDS") is being filed more than three months after the filing date of the above-referenced application. An office action has not been received, and thus no fee is believed to be due in connection with this SIDS. If any fee is deemed to be due, please charge it to Deposit Account No. 50-0549.

This SIDS encloses a number of litigation documents. U.S. Patent No. 6,743,758 B2 (the “‘758 patent”, parent to the present application) and U.S. Patent No. 6,495,494 B1 (the “‘494 patent”, grandparent to the present application), both assigned to Ecolab, are currently the subject of pending litigation in the U.S. District Court, District of Minnesota. The litigation is captioned Ecolab, Inc. v. JohnsonDiversey, Inc., Case No. 0:03-cv-02231. Plaintiff Ecolab commenced the litigation by asserting infringement of the ‘494 patent in a Complaint filed March 7, 2003, followed by a Motion for Preliminary Injunction filed March 28, 2003. Defendant JohnsonDiversey, Inc. (“JohnsonDiversey”) filed a number of memoranda and declarations in response, and cited several patents and other documents as allegedly invalidating the ‘494 patent. The District Court issued a Memorandum, Opinion and Order on May 29, 2003 (“District Court Decision”) denying Ecolab’s Motion for Preliminary Injunction, based at least in part on the District Court’s construction of the phrase “water-miscible lubricant”. The Court of Appeals for the Federal Circuit issued a decision on April 6, 2004 (“Federal Circuit Opinion”) reversing the District Court Decision. The litigation is presently in the discovery stage.

During prosecution of the application (the “‘559 application”) that eventually became the ‘758 patent, the undersigned attorney met in an in-person interview with Examiner McAvoy (the Examiner in charge of the ‘559 application) to discuss an Office Action, cited references, a draft amendment, and some of the patents that JohnsonDiversey asserted in the litigation as invalidating the ‘494 patent. The interview took place on October 22, 2003. The attorney described to the Examiner the litigation and issues raised, and advised the Examiner that an SIDS would be submitted in the ‘559 application to cite information and documents from the litigation and documents cited in an Ecolab patent prosecuted by another law firm. The Examiner requested that the SIDS include only patents and other documents that might qualify as prior art, and that the SIDS not include pleadings, memoranda and motions submitted by the parties or the District Court Decision. The Examiner pointed out that these various court papers would not qualify as prior art and could not form the basis for a rejection.

An Amendment, Terminal Disclaimer under 37 CFR 1.321 and a Request for Two Month Extension of Time to Reply were filed via facsimile in the ‘559 application on October 29, 2003. An SIDS citing and enclosing copies of 52 patents and 12 other documents was filed via mail in the ‘559 application on the same day. As requested by the Examiner, the October 29, 2003 SIDS

included all patents and other documents from the litigation that might qualify as prior art under 35 USC §102.

A further SIDS identifying the litigation, enclosing a copy of the Complaint and PACER system Docket Report, and offering if desired by the Examiner to provide copies of any of the other papers filed in the litigation, was filed via facsimile on November 13, 2003.

The '559 application issued as the '758 patent on June 1, 2004. Ecolab amended its Complaint to assert infringement of the '758 patent on June 10, 2004.

JohnsonDiversey filed an Answer and Counterclaim to Plaintiff's Amended Complaint ("Counterclaim") on July 2, 2004. The Counterclaim alleged, *inter alia*, that the '758 patent was unenforceable due to inequitable conduct by the undersigned attorney and others for failure in the '559 application to submit or to provide the other court papers not included in the October 29, 2003 SIDS. Ecolab and the undersigned attorney believe that JohnsonDiversey's inequitable conduct allegation is improper, and are opposing it. Meanwhile pursuant to the first paragraph of MPEP §2001.06(c), applicants are bringing JohnsonDiversey's inequitable conduct allegation to the attention of the Examiner in charge of the present application.

This SIDS includes copies of the District Court and Federal Circuit Docket sheets, District Court Decision, Federal Circuit Opinion and various other court papers and exhibits from the litigation. Particulars concerning JohnsonDiversey's inequitable conduct allegation may be found, for example, in paragraphs 72 through 173 of the Counterclaim. A list of allegedly withheld material information may be found in paragraph 144. Assertions that applicants did not advise the USPTO of a dispute over the meaning of the phrase "water-miscible lubricant" may be found in paragraphs 159 through 173.

To further assist the Examiner, the dates of the court papers and exhibits enclosed with this SIDS (and the dates of other exhibits not enclosed with this SIDS but submitted in the present application in a November 18, 2003 Information Disclosure Statement ("IDS") or submitted in the '559 application in an April 17, 2001 SIDS) are as follows:

Item No.	Item	Asserted Date, if known	Date submitted to USPTO
1.	Docket Sheet for U.S. District Court, District of Minnesota, <u>Ecolab, Inc. v. JohnsonDiversey, Inc.</u> , Case No. 0:03-cv-02231	October 25, 2004	Herewith. An earlier version was submitted in the November 13, 2003 '559 application SIDS.
2.	Docket Sheet for U.S. Court of Appeals for the Federal Circuit, Ecolab v. JohnsonDiversey, Inc., Case No.: 0:03-cv-02231	October 25, 2004	Herewith
3.	Complaint	March 7, 2003	Herewith. Also submitted in the November 13, 2003 '559 application SIDS
3-A.	U.S. Patent No. 6,495,494 B1 (Exhibit A to Item No. 3)	December 17, 2002 (filed June 16, 2000)	Not submitted (grandparent patent in suit)
4.	Ecolab's Memorandum of Law in Support of Its Motion for a Preliminary Injunction	March 28, 2003	Herewith
5.	Declaration of Tom Arata	March 28, 2003	Herewith
6.	Declaration of David Cleveland	March 28, 2003	Herewith

Item No.	Item	Asserted Date, if known	Date submitted to USPTO
6-A.	U.S. Patent No. 6,495,494 B1 (Exhibit A to Item No. 6)	December 17, 2002 (filed June 16, 2000)	Not submitted (grandparent patent in suit)
6-B.	PCT Published Application No. WO 01/12759 A2 (Exhibit B to Item No. 6)	February 22, 2002	Herewith
6-C.	Opinion Letter (Exhibit C to Item No. 6)	March 25, 2003	Herewith
6-C-A.	U.S. Patent No. 6,495,494 B1 (Attachment A to Item No. 6-C)	December 17, 2002 (filed June 16, 2000)	Not submitted (grandparent patent in suit)
6-C-B.	Ecolab Analytical & Physical Chemistry Analysis Report (Attachment B to Item No. 6-C)	February 4, 2003	Herewith
6-C-C.	Product Information Sheet for DOWANOL DPM (Attachment C to Item No. 6-C)	August 2001	Herewith
6-C-D.	Dicolube TPB (Johnson Diversey Product Information, Attachment D to Item No. 6-C)	2002 or 2003	Herewith
6-C-E.	DICOLUBE TPB Material Safety Data Sheet (Attachment E to Item No. 6-C)	June 20, 2002	Herewith
6-C-F.	Lubricity Properties of DPM (Attachment F to Item No. 6-C)	2003	Herewith
6-D.	Dicolube System Dicolube TPB (Exhibit D to Item No. 6)	2002 or 2003	Herewith

Item No.	Item	Asserted Date, if known	Date submitted to USPTO
7.	Declaration of Amy McBroom	March 28, 2003	Herewith
7-A.	Product Information Sheet for DOWANOL DPM (Exhibit A to Item No. 7)	August 2001	Herewith
7-B.	Ecolab Analytical & Physical Chemistry Analysis Report (Exhibit B to Item No. 7)	September 5, 2000	Herewith
7-C.	Dicolube TPB (Johnson Diversey Product Information, Exhibit C to Item No. 7)	2002 or 2003	Herewith
7-D.	Ecolab Analytical & Physical Chemistry Analysis Report (Exhibit D to Item No. 7)	February 4, 2003	Herewith
7-E.	DICOLUBE TPB Material Safety Data Sheet (Exhibit E to Item No. 7)	June 20, 2002	Herewith
7-F.	Lubricity Properties of DPM (Exhibit F to Item No. 7)	2003	Herewith
8.	Declaration of Rachel Zimmerman	March 28, 2003	Herewith
8-A.	JohnsonDiversey Form 8-K	March 25, 2003	Herewith
9.	Answer and Counterclaim	April 8, 2003	Herewith
10.	JohnsonDiversey's Memorandum of Law in Opposition to Ecolab's Motion for a Preliminary Injunction	April 25, 2003	Herewith
11.	Declaration of Tim A. Osswald	April 25, 2003	Herewith
11-A.	Curriculum Vitae, Tim Andreas Osswald (Exhibit A to Item No. 11)	2003	Herewith

Item No.	Item	Asserted Date, if known	Date submitted to USPTO
11-B.	T. Osswald's Prior Testimony (Exhibit B to Item No. 11)	2002 or 2003	Herewith
11-C.	DOWANOL DPM (Exhibit C to Item No. 11)	April 13, 2003	Herewith
11-D.	Dicolube TPB (Johnson Diversey Product Information, Exhibit D to Item No. 11)	2002 or 2003	Herewith
11-E.	DICOLUBE TPB Material Safety Data Sheet (Exhibit E to Item No. 11)	June 20, 2002	Herewith
12.	Declaration of Dr. Harriet Black Nemhard	April 25, 2003	Herewith
12-A.	Minitab Output of Descriptive Statistics and Confidence Intervals on COF Data for Water, 67 ppm DPM, and 133 ppm DPM (Exhibit A to Item No. 12)	2003	Herewith
13.	Declaration of Jacques Rouillard ¹	April 25, 2003	Herewith
13-A.	Product Information Sheet for DOWANOL DPM (Exhibit A to Item No. 13)	August 2001	Herewith
13-B.	Report for Project A-258, M. Stanga, Diversey S.p.A. (Exhibit B to Item No. 13)	December 1996	Herewith

¹ Pages 11 – 13 in the Rouillard Declaration provide observations about U.S. Patent Nos. 4,420,578, 5,139,834, 5,174,914, 5,559,087 and 5,925,601. These patents were submitted to the USPTO in the November 18, 2003 IDS.

Item No.	Item	Asserted Date, if known	Date submitted to USPTO
13-C.	Report for Project A-260, M. Stanga, F. Bruschi, G. Bonaldi (Exhibit C to Item No. 13)	September 1997	Herewith
13-D.	Revised List of Conveyor Lubricants Compatible with PET Containers (Exhibit D to Item No. 13)	April 10, 1986	Herewith
13-E.	"Continuous improvement...the essence of success", <i>Quality Control Corner, Beverage World</i> (Exhibit E to Item No. 13)	July 1996	Submitted in the November 18, 2003 IDS
13-F.	Testing Protocol (Exhibit F to Item No. 13)	Believed to be 2003	Herewith
14.	Declaration of Keith W. Kennedy	April 24, 2003	Herewith
14-A.	DiverseyLever Core-Euro Formulation (Exhibit A to Item No. 14)	June 1, 2000	Submitted in the November 18, 2003 IDS
14-B	JohnsonDiversey Food Group Duplicate Invoice for Dicolube TP (Exhibit B to Item No. 14)	May 9, 1996	Submitted in the November 18, 2003 IDS
14-C.	Material Safety Data Sheet for Dicolube TP (Exhibit C to Item No. 14)	April 11, 1996	Submitted in the November 18, 2003 IDS
14-D.	Report for Project A-260, M. Stanga, F. Bruschi, G. Bonaldi (Exhibit D to Item No. 14)	September 1997	Herewith

Item No.	Item	Asserted Date, if known	Date submitted to USPTO
14-E.	Track Treatment Workshop, Alzey, Germany (Exhibit E to Item No. 14)	March 31, 1998 – April 1, 1998	Herewith
15.	Declaration of Michael K. Lammers	April 25, 2003	Herewith
15-A.	Dicolube TPB Sales (Exhibit A to Item No. 15)	April, 2003	Herewith
16.	Declaration of Christopher G. Hanewicz	April 25, 2003	Herewith
16-A.	Table of Anticipatory Prior Art (Appendix A to Item No. 16)	2003	Herewith
16-B.	Invalidity Analysis of Claims 4,7,9,14-19,24,27 and 30-32 (Appendix B to Item No. 16)	2003	Herewith
16-C.	U.S. Patent No. 6,495,494 B1 (Exhibit C to Item No. 16)	December 17, 2002 (filed June 16, 2000)	Not submitted (grandparent patent in suit)
16-D.	U.S. Patent No. 4,420,578 (Exhibit D to Item No. 16)	December 13, 1983 (filed September 14, 1981)	Submitted in the November 18, 2003 IDS
16-E.	U.S. Patent No. 5,139,834 (Exhibit E to Item No. 16)	August 18, 1992 (parent filed October 29, 1980)	Submitted in the November 18, 2003 IDS
16-F.	U.S. Patent No. 5,043,380 (Exhibit F to Item No. 16)	August 27, 1992 (filed October 29, 1980)	Submitted in the November 18, 2003 IDS
16-G.	U.S. Patent No. 5,174,914 (Exhibit G to Item No. 16)	December 29, 1992 (filed June 16, 1991)	Submitted in the November 18, 2003 IDS

Item No.	Item	Asserted Date, if known	Date submitted to USPTO
16-H.	U.S. Patent No. 5,559,087 (Exhibit H to Item No. 16)	September 24, 1996 (filed June 28, 1994)	Submitted in the November 18, 2003 IDS
16-I.	U.S. Patent No. 5,925,601 (Exhibit I to Item No. 16)	July 20, 1999 (filed October 13, 1998)	Submitted in the November 18, 2003 IDS
16-J.	U.S. Patent No. 5,935,914 (Exhibit J to Item No. 16)	August 10, 1999 (filed October 15, 1997)	Submitted in the November 18, 2003 IDS
16-K.	U.S. Patent No. 5,747,431 (Exhibit K to Item No. 16)	May 5, 1998 (filed Feb 3, 1997)	Submitted in the November 18, 2003 IDS
16-L.	U.S. Patent No. 5,202,037 (Exhibit L to Item No. 16)	April 13, 1993 (filed October 2, 1989)	Submitted in the November 18, 2003 IDS
16-M.	U.S. Patent No. 4,769,162 (Exhibit M to Item No. 16)	September 6, 1988 (filed June 12, 1987)	Submitted in the November 18, 2003 IDS
16-N.	U.S. Patent No. 5,391,308 (Exhibit N to Item No. 16)	February 21, 1995 (filed March 8, 1993)	Submitted in the November 18, 2003 IDS

Item No.	Item	Asserted Date, if known	Date submitted to USPTO
16-O.	U.S. Patent No. 5,062,979 (Exhibit O to Item No. 16)	November 5, 1991 (filed September 13, 1989)	Submitted in the November 18, 2003 IDS
16-P.	European Patent Application EP 99305796.7 (Exhibit P to Item No. 16)	Not yet published ²	Herewith
17.	Ecolab's Reply Memorandum of Law in Support of Its Motion for a Preliminary Injunction	May 5, 2003	Herewith
18.	Reply Declaration of Tom Arata	May 2, 2003	Herewith
19.	Second Declaration of David R. Cleveland	May 4, 2003	Herewith
19-A.	April 17, 2001 SIDS in the '599 application (Exhibit A to Item No. 19)	April 17, 2001	Submitted in the April 17, 2001 '559 application SIDS
19-B.	U.S. Patent No. 4,062,785 (Exhibit B to Item No. 19)	December 13, 1977 (filed February 23, 1976)	Submitted in the November 18, 2003 IDS
19-C.	U.S. Patent No. 4,709,806 (Exhibit C to Item No. 19)	December 1, 1987 (parent filed July 13, 1984)	Submitted in the November 18, 2003 IDS

² According to the European Patent Office's Online Public File Inspection service at <http://ofi.epoline.org/view/GetDossier?dosnum=&lang=EN> this application has not yet published

Item No.	Item	Asserted Date, if known	Date submitted to USPTO
19-D.	U.S. Patent No. 5,427,258 (Exhibit D to Item No. 19)	June 27, 1995 (filed March 26, 1993)	Submitted in the November 18, 2003 IDS
20.	Reply Declaration of Thomas J. Hairston, Ph.D.	May 2, 2003	Herewith
20-A.	Curriculum Vitae, Thomas J. Hairston, Ph.D. (Exhibit E to Item No. 20)	2003	Herewith
21.	Reply Declaration of Amy McBroom	May 2, 2003	Herewith
22.	Declaration of Mario Stanga	May 9, 2003	Herewith
22-1.	Graph 1 BIS ((Exhibit 1 to Item No. 22)	September 1997	Herewith
23.	Declaration of Mark Kassel ³	May 15, 2003	Herewith
23-A.	Curriculum Vitae, Mark A. Kassel (Exhibit A to Item No. 23)		Herewith
23-B.	Claim Chart (Exhibit B to Item No. 23)	2003	Herewith

³ Page 28 (see numbered paragraph 61) in the Kassel Declaration refers to U.S. Patent Nos. 5,559,087, 5,174,914, "5,952,601" (believed to be a reference to U.S. Patent No. 5,925,601, as U.S. Patent No. 5,952,601 is entitled "RECOILLESS AND GAS-FREE PROJECTILE PROPULSION"), 6,087,308, 4,062,785 and 5,062,979. The '087, '914, 5,925,601, '308, '785 and '979 patents were submitted to the USPTO in the November 18, 2003 IDS. Page 29 (see numbered paragraph 62) in the Kassel Declaration refers to U.S. Patent Nos. 4,420,578, 5,043,380, 5,139,834, 5,174,914, 5,559,087, 5,925,601, 4,062,785, 6,060,444 and 6,087,308. These patents were submitted to the USPTO in the November 18, 2003 IDS.

Item No.	Item	Asserted Date, if known	Date submitted to USPTO
23-C.	Technical Bulletin MAZU® DF210 S 10% Silicone Defoamer (Exhibit C to Item No. 23)	2002	Submitted in the November 18, 2003 IDS
23-D.	U.S. Patent No. 6,060,444 (Exhibit D to Item No. 23)	May 9, 2000 (grandparent filed December 30, 1993)	Submitted in the November 18, 2003 IDS
23-E.	1520 Silicone Antifoam Brochure, <i>Dow Corning Webpage</i> (Exhibit E to Item No. 23)	May 2003	Herewith
23-F.	U.S. Patent No. 6,087,308 (Exhibit F to Item No. 23)	July 11, 2000 (filed December 22, 1998)	Submitted in the November 18, 2003 IDS
23-G.	U.S. Patent No. 5,062,979 (Exhibit G to Item No. 23)	November 5, 1991 (filed September 13, 1989)	Submitted in the November 18, 2003 IDS
23-H.	U.S. Patent Application No. 09/619,261 (Exhibit H to Item No. 23)	July 19, 2000	Herewith
24.	Third Declaration of David R. Cleveland	May 23, 2003	Herewith
25.	District Court Decision	May 29, 2003	Herewith
26.	Ecolab's Appeal Brief	August 11, 2003	Herewith
27.	JohnsonDiversey's Appeal Brief	September 22, 2003	Herewith
28.	Ecolab's Reply Brief	October 23, 2003	Herewith
29.	Federal Circuit Opinion	April 6, 2004	Herewith
30.	Ecolab's Amended Complaint	June 10, 2004	Herewith

Item No.	Item	Asserted Date, if known	Date submitted to USPTO
30-A.	U.S. Patent No. 6,495,494 B1 (Exhibit A to Item No. 30)	December 17, 2002 (filed June 16, 2000)	Not submitted (grandparent patent in suit)
30-B.	U.S. Patent No. 6,673,753 B2 (Exhibit B to Item No. 30)	January 6, 2004 (parent filed June 16, 2000)	Not submitted (parent patent in suit)
30-C.	U.S. Patent No. 6,743,758 B2 (Exhibit C to Item No. 30)	June 1, 2004 (parent filed June 16, 2000)	Not submitted (continuation of grandparent patent in suit)
31.	JohnsonDiversey's Answer and Counterclaim to Ecolab's Amended Complaint	July 2, 2004	Herewith
32	Ecolab's Reply to JohnsonDiversey's Counterclaim	August 11, 2004	Herewith

Most of the items referred to above:

- a) were submitted in the November 18, 2003 IDS, or
- b) are dated after the June 16, 2000 effective filing date for the present application.

None of the items referred to above are believed to identify with particularity any assertions made by applicants in the litigation that would be contradictory to assertions made by applicants to the Examiner responsible for the '494 patent and '758 patent. Applicants do not believe they have made any such contradictory assertions.

As to some of the remaining items referred to above:

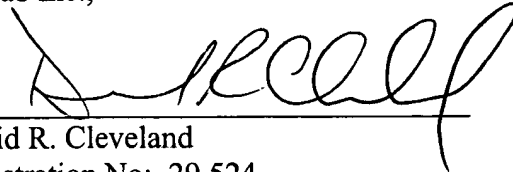
- a) Item Nos. 13-B and 13-C are both believed to be unpublished Diversey S.p.A., JohnsonDiversey, Inc. or DiverseyLever, Inc. company documents (see e.g., the Rouillard Declaration, Item No. 13, numbered paragraph 12 at pages 4 – 5).

- b) Item No. 13-D is believed to be an unpublished South Eastern Containers Corp., JohnsonDiversey, Inc. or DiverseyLever, Inc. company document (see e.g., the Rouillard Declaration, Item No. 13, numbered paragraph 14 at page 5).
- c) Dicolube TP has been alleged by JohnsonDiversey to have been offered for sale in the U.S. prior to June 16, 2000 but is believed not to have contained both a water-miscible silicone material and a water-miscible lubricant (see e.g., the Kennedy Declaration, Item No. 14, numbered paragraphs 9 and 12 – 14 at pages 3 – 4 and Item Nos. 14-A through 14-C).
- d) Dicolube TPB has been alleged by JohnsonDiversey to have been offered for sale in Europe prior to June 16, 2000 but is not believed to have been known or used by others in the U.S., patented or described in a printed publication in this or a foreign country, or in public use or on sale in the U.S. prior to June 16, 2000 (see e.g., the Kennedy Declaration, Item No. 14, numbered paragraphs 6 – 12 and 16 – 19 at pages 2 – 5).
- e) Item No. 14-D is believed to be an unpublished Diversey S.p.A., JohnsonDiversey, Inc. or DiverseyLever, Inc. company document (see e.g., the Kennedy Declaration, Item No. 14, numbered paragraphs 16 – 18 at pages 4 – 5).
- f) Item No. 14-E is believed to be an unpublished DiverseyLever, Inc. internal workshop presentation made in Germany (see e.g., the Kennedy Declaration, Item No. 14, numbered paragraph 19 at page 5).
- g) Item No. 16-P is believed to be an unpublished European Patent Application (see the European Patent Office's Online Public File Inspection service at <http://ofi.epoline.org/view/GetDossier?dosnum=&lang=EN>).
- h) Item no. 22-1 is believed to be an unpublished Diversey S.p.A. company document (see e.g., the Stanga Declaration, Item No. 22, numbered paragraph 9 at pages 4 – 5).

The District Court Decision and Federal Circuit Opinion are being separately submitted under MPEP §2207, so that they can be placed in the patent file in any event. If desired by the Examiner, applicants can provide copies of any of the other papers filed in the litigation (e.g.,

interrogatories and responses, deposition transcripts, and the like) and not already included with this SIDS, subject to applicable confidentiality restrictions. The Examiner is also invited to contact Applicants' Representative at the below-listed telephone number, if there are any questions regarding this SIDS or if any other assistance is needed during prosecution of the present application.

Respectfully submitted on behalf of
Ecolab Inc.,

A handwritten signature in black ink, appearing to read "D. R. Cleveland", is written over a horizontal line.

October 28, 2004

David R. Cleveland
Registration No: 29,524
612-331-7412 (telephone)
612-331-7401 (facsimile)
USPTO Customer No. 23322

IPLM Group, P.A.
P.O. Box 18455
Minneapolis, MN 55418

Substitute for Form 1449/PTO INFORMATION DISCLOSURE STATEMENT BY APPLICANT	Complete if Known	
	Application Number	10/715,575
	Filing Date	November 18, 2003
	First Named Inventor	Minyu Li
	Art Unit	3651
	Examiner Name	unknown
	Attorney Docket No.	117-P-1380USC3

U.S. PATENT DOCUMENTS

Examiner Initials	Item No.	Document Number	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number-Kind Code			
	23-H	US-09/619,261 (Exhibit H to Item No. 23)	07/19/2000		

FOREIGN PATENT DOCUMENTS

Examiner Initials	Item No.	Foreign Patent Document	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages Or Relevant Figures Appear	T
		Country Code/Number/Kind Code				
	6-B	WO 01/12759 A2 (Exhibit B to Item No. 6)	02/22/2002	PCT		
	16-P	EP 99305796.7 (Exhibit P to Item No. 16)	Not yet published	EP		

NON PATENT LITERATURE DOCUMENTS

Examiner Initials	Item No.	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T
	1	Docket Sheet for U.S. District Court, District of Minnesota, <u>Ecolab, Inc. v. JohnsonDiversey, Inc.</u> , Case No. 0:03-cv-02231, October 25, 2004	
	2	Docket Sheet for U.S. Court of Appeals for the Federal Circuit, <u>Ecolab, Inc. v. JohnsonDiversey, Inc.</u> , Case No.: 0:03-cv-02231, October 25, 2004	
	3	Complaint, U.S. District Court, District of Minnesota, <u>Ecolab, Inc. v. JohnsonDiversey, Inc.</u> , Case No. 0:03-cv-02231 March 7, 2003	
	4	Ecolab's Memorandum of Law in Support of Its Motion for a Preliminary Injunction, March 28, 2003	
	5	Declaration of Tom Arata, March 28, 2003	
	6	Declaration of David Cleveland, March 28, 2003	

EXAMINER	Date Considered
*Examiner: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.	

Substitute for Form 1449/PTO INFORMATION DISCLOSURE STATEMENT BY APPLICANT	Complete if Known	
	Application Number	10/715,575
	Filing Date	November 18, 2003
	First Named Inventor	Minyu Li
	Art Unit	3651
	Examiner Name	unknown
	Attorney Docket No.	117-P-1380USC3

	6-C	Opinion Letter (Exhibit C to Item No. 6), March 25, 2003	
	6-C-B	Ecolab Analytical & Physical Chemistry Analysis Report (Attachment B to Item No. 6-C), February 4, 2003	
	6-C-C	Product Information Sheet for DOWANOL DPM (Attachment C to Item No.6-C), August 2001	
	6-C-D	Dicolube TPB (Johnson Diversey Product Information, Attachment D to Item No. 6-C), 2002 or 2003	
	6-C-E	DICOLUBE TPB Material Safety Data Sheet (Attachment E to Item No. 6-C), June 20, 2002	
	6-C-F	Lubricity Properties of DPM (Attachment F to Item No. 6-C), 2003	
	6-D	Dicolube System Dicolube TPB (Exhibit D to Item No. 6), 2002 or 2003	
	7	Declaration of Amy McBroom, March 28, 2003	
	7-A	Product Information Sheet for DOWANOL DPM (Exhibit A to Item No. 7), August 2001	
	7-B	Ecolab Analytical & Physical Chemistry Analysis Report (Exhibit B to Item No.7), September 5, 2000	
	7-C	Dicolube TPB (Johnson Diversey Product Information, Exhibit C to Item No. 7), 2002 or 2003	
	7-D	Ecolab Analytical & Physical Chemistry Analysis Report (Exhibit D to Item No.7), February 4, 2003	
	7-E	DICOLUBE TPB Material Safety Data Sheet (Exhibit E to Item No. 7), June 20, 2002	
	7-F	Lubricity Properties of DPM (Exhibit F to Item No. 7), 2003	
	8	Declaration of Rachel Zimmerman, March 28, 2003	
	8-A	JohnsonDiversey Form 8-K, March 25, 2003	
	9	Answer and Counterclaim, U.S. District Court, District of Minnesota, <u>Ecolab, Inc. v. JohnsonDiversey, Inc.</u> , Case No. 0:03-cv-02231, April 8, 2003	
	10	JohnsonDiversey's Memorandum of Law in Opposition to Ecolab's Motion for a Preliminary Injunction, April 25, 2003	
	11	Declaration of Tim A. Osswald, April 25, 2003	

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	Application Number	10/715,575
	Filing Date	November 18, 2003
	First Named Inventor	Minyu Li
	Art Unit	3651
	Examiner Name	unknown
	Attorney Docket No.	117-P-1380USC3

	11-A	Curriculum Vitae, Tim Andreas Osswald (Exhibit A to Item No. 11), 2003	
	11-B	T. Osswald's Prior Testimony (Exhibit B to Item No. 11), 2002 or 2003	
	11-C	DOWANOL DPM (Exhibit C to Item No. 11), April 13, 2003	
	11-D	Dicolube TPB (Johnson Diversey Product Information, Exhibit D to Item No. 11), 2002 or 2003	
	11-E	DICOLUBE TPB Material Safety Data Sheet (Exhibit E to Item No. 11), June 20, 2002	
	12	Declaration of Dr. Harriet Black Nemhard, April 25, 2003	
	12-A	Minitab Output of Descriptive Statistics and Confidence Intervals on COF Data for Water, 67 ppm DPM, and 133 ppm DPM (Exhibit A to Item No. 12), 2003	
	13	Declaration of Jacques Rouillard, April 25, 2003	
	13-A	Product Information Sheet for DOWANOL DPM (Exhibit A to Item No. 13), August 2001	
	13-B	Report for Project A-258, M. Stanga, Diversey S.p.A. (Exhibit B to Item No. 13), December 1996	
	13-C	Report for Project A-260, M. Stanga, F. Bruschi, G. Bonaldi (Exhibit C to Item No. 13), September 1997	
	13-D	Revised List of Conveyor Lubricants Compatible with PET Containers (Exhibit D to Item No. 13), April 10, 1986	
	13-F	Testing Protocol (Exhibit F to Item No. 13), believed to be 2003	
	14	Declaration of Keith W. Kennedy, April 24, 2003	
	14-D	Report for Project A-260, M. Stanga, F. Bruschi, G. Bonaldi, September 1997 (Exhibit D to Item No. 14)	
	14-E	Track Treatment Workshop, Alzey, Germany (Exhibit E to Item No. 14), March 31, 1998 – April 1, 1998	
	15	Declaration of Michael K. Lammers, April 25, 2003	
	15-A	Dicolube TPB Sales (Exhibit A to Item No. 15), April, 2003	
	16	Declaration of Christopher G. Hanewicz, April 25, 2003	
	16-A	Table of Anticipatory Prior Art (Appendix A to Item No. 16), 2003	

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16-B	Invalidity Analysis of Claims 4,7,9,14-19,24,27 and 30-32 (Appendix B to Item No. 16), 2003	
17	Ecolab's Reply Memorandum of Law in Support of Its Motion for a Preliminary Injunction, May 5, 2003	
18	Reply Declaration of Tom Arata, May 2, 2003	
19	Second Declaration of David R. Cleveland, May 4, 2003	
20	Reply Declaration of Thomas J. Hairston, Ph.D., May 2, 2003	
20-A	Curriculum Vitae, Thomas J. Hairston, Ph.D. (Exhibit E to Item No. 20), 2003	
21	Reply Declaration of Amy McBroom, May 2, 2003	
22	Declaration of Mario Stanga, May 9, 2003	
22-1	Graph 1 BIS ((Exhibit 1 to Item No. 22), September 1997	
23	Declaration of Mark Kassel, May 15, 2003	
23-A	Curriculum Vitae, Mark A. Kassel (Exhibit A to Item No. 23)	
23-B	Claim Chart (Exhibit B to Item No. 23), 2003	
23-E	1520 Silicone Antifoam Brochure, <i>Dow Corning Webpage</i> (Exhibit E to Item No.23), May 2003	
24	Third Declaration of David R. Cleveland, May 23, 2003	
25	Memorandum, Opinion and Order, U.S. District Court, District of Minnesota, <u>Ecolab, Inc. v. JohnsonDiversey, Inc.</u> , Case No. 0:03-cv-02231, May 29, 2003	
26	Ecolab's Appeal Brief, U.S. Court of Appeals for the Federal Circuit, <u>Ecolab Inc. v. JohnsonDiversey, Inc.</u> , Case No.: 0:03-cv-02231, August 11, 2003	
27	JohnsonDiversey's Appeal Brief, U.S. Court of Appeals for the Federal Circuit, <u>Ecolab, Inc. v. JohnsonDiversey, Inc.</u> , Case No.: 0:03-cv-02231, September 22, 2003	
28	Ecolab's Reply Brief, U.S. Court of Appeals for the Federal Circuit, <u>Ecolab, Inc. v. JohnsonDiversey, Inc.</u> , Case No.: 0:03-cv-02231, October 23, 2003	
29	Federal Circuit Opinion, U.S. Court of Appeals for the Federal Circuit, <u>Ecolab, Inc. v. JohnsonDiversey, Inc.</u> , Case No.: 0:03-cv-02231, April 6, 2004	

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	30	Ecolab's Amended Complaint, U.S. District Court, District of Minnesota, <u>Ecolab, Inc. v. JohnsonDiversey, Inc.</u> , Case No. 0:03-cv-02231, June 10, 2004	
	31	JohnsonDiversey's Answer and Counterclaim to Ecolab's Amended Complaint, U.S. District Court, District of Minnesota, <u>Ecolab, Inc. v. JohnsonDiversey, Inc.</u> , Case No. 0:03-cv-02231, July 2, 2004	
	32	Ecolab's Reply to JohnsonDiversey's Counterclaim, U.S. District Court, District of Minnesota, <u>Ecolab, Inc. v. JohnsonDiversey, Inc.</u> , Case No. 0:03-cv-02231, August 11, 2004	

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